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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,309	08/24/2001	Yoichiro Sako	7246/63317	2273
530 7590 08/04/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER SHERR, CRISTINA O				
ART UNIT 3685		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/914,309

Applicant(s)

SAKO ET AL.

Examiner

CRISTINA OWEN SHERR

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 41-43, 45, 46 and 48-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 41-43, 45, 46 and 48-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date 07/03/08.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to Applicants' Amendment filed February 18, 2008. Claims 1-5, 41-43, 45-46, and 48-52 are currently pending in this case. Claims 44 and 47 have been currently canceled. Claims 1, 2, 4, 41, 42, 43, 45, 46, 48, 49, 51, and 52 are currently amended.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 18, 2008 has been entered.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on July 3, 2008 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

4. Applicant's arguments with respect to the claims, as currently amended, have been considered but are moot in view of the new ground(s) of rejection.

5. Claim 2 has been amended to recite "wherein one of *the use* of and operation of *the use* permission data *is disabled while sending* the use history information to the external device" (emphasis added). However, this is intended use and it has been held

that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). Claims 42, 43, 46, 48, and 51 also recite similar intended use/functional language.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the clause:

"a receiving unit configured to receive digital data from a recording medium or through the communication unit, use of the received digital data employ use permission data;" (present in all the above-named claims)

is vague and unclear and thus fails to properly set forth the metes and bounds of the claimed invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5, 41-43, 45-46, and 48-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al (US 6,233,684) ("Stefik1") in view of Stefik et al (US 5,628,980) ("Stefik2").
10. Regarding claims 1, 4, 41, 45 and 4 –
11. Stefik1 discloses a digital data processing apparatus (fig 4) comprising:
 - a communicating unit configured to communicate with an external device (e.g. fig 1, fig 3);
 - a receiving unit configured to receive digital data from a recording medium or through the communication unit, use of the received digital data employ use permission data (e.g. fig 5; fig 6; col 9 ln 14-28; col 8 ln 5-38);
 - a memory in which use history information of the digital data has been stored; (col 10 ln 6-18).
12. Stefik2 discloses, where Stefik1 does not, a controller configured to send the use history information to the external device through the communication unit when an accumulation of uses of the digital data reaches a preset value. (e.g. col 22 ln 57- col 23 10).
13. It would be obvious to one of ordinary skill in the art to combine the teachings of Stefik1 and Stefik2 since they refer to each other in their descriptions, and are clearly in the same field of digital rights management.
14. Regarding the limitation of claim 2 –

15. Stefik2 discloses wherein after the transfer is induced one of the use of and an operation of the use permission data is disabled during the transfer of the use history information. (e.g. col 23 ln 15-20).
16. Regarding the limitation of claims 3, 5 –
17. Stefik2 discloses wherein the digital data are one of audio data, video data, still image data, character data, computer graphics data, game software, and a computer program (e.g. col 4 ln 29-32, col 6 ln 37-50, col 3 ln 50-60).
18. Regarding claim 42, 48, 52 –
19. Stefik2 discloses a display unit, wherein the display unit displays a message for urging a user to send the reproduction history data to the exterior element when the reproduction history data written in the memory unit reach the predetermined value. (e.g. col 8 ln 55- col 9 ln 5, table 1).
20. Regarding claim 43, 51 –
21. Stefik2 discloses wherein the control unit inhibits the signal process by the signal processing unit data is finished while sending the reproduction history data to the exterior element. (e.g. col 23 ln 15-20).
22. Regarding claim 46 –
23. Stefik2 discloses wherein the control unit sends the reproduction history data stored in the memory unit when the control unit receives data regarding an electronic monitoring permission from the exterior element, the data regarding an electronic monitoring permission being used for reproducing the content data. (e.g. col 22 ln 57- col 23 ln 10).

24. Regarding claim 49 –

25. Stefik2 discloses a second display unit, wherein the second display unit displays an indicator, the indicator changes the length of a predetermined color part in accordance with an amount of available space of the memory unit (e.g. col 8 In 55- col 9 In 5, table 1).

26. Regarding claim 50 –

27. Stefik2 discloses a warning display unit for displaying that the reproduction history data written in the memory unit have reached the predetermined value. (e.g. col 8 In 55- col 9 In 5, table 1).

28. Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

30. Stefik et al (US 5,638,443) disclose a system for controlling the distribution and use of composite digital works.

31. Sims, III (US 6,438,235) discloses media content protection utilizing public key cryptography.
32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA OWEN SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.
33. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cristina Owen Sherr, AU 3685
/Calvin L Hewitt II/

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Supervisory Patent Examiner, Art Unit 3685